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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/750,987	01/05/2004	Florence Laurent	6028.0007-01	5488

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EXAMINER	
EINSMANN, MARGARET V	
ART UNIT	**PAPER NUMBER**
1751	

DATE MAILED: 12/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/750,987	LAURENT ET AL.	
	Examiner	Art Unit	
	Margaret Einsmann	1751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☐ Claim(s) *9-15,25,36,39,52 and 71* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) *9-15, 25, 36, 39, 52 and 71* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☒ Certified copies of the priority documents have been received in Application No. 09/263954.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *6/2/04*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

This action is in response to the preliminary amendment in which claims 1-9, 16-24, 26-35 and 37,38 , 40-51 and 53-70 have been canceled. Since claim 9 is the independent claim on which all of the remaining claims depend, in the interest of compact prosecution this office is treating the cancellation of claim 9 as an inadvertent error. This application is being examined as if claim 9 were pending. Accordingly claims 9-15, 25, 36, 39, 52 and 71 are being examined.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 9-15, 25, 36, 39, 52 and 71 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 9, the two choices are not mutually exclusive. If one selects the second option, he is also selecting the first option since a quaternized hydroxyethyl cellulose is a quaternized cellulose. Furthermore, applicant has not identified in the specification any quaternized celluloses which are not hydroxyethylcelluloses.

In claim 9 and its dependent claims there is no nexus between the preamble and the body of the composition claim since there is no oxidizing component in the claimed composition. Accordingly, the claim may be rejected on any composition comprising the quaternized cellulose component.

Also in claim 9, the phrase (repeated twice) "containing at least 8 carbon atoms" is indefinite because it is open-ended. The examiner suggests the addition of the limitations of claims 10 and 11 into claim 9.

Claims 12 -15 are rejected as being redundant since they do not further limit the composition of claim 9.

Claim 52 is unclear and apparently redundant because according to Cotteret et al., US 5,735,908 column 3 lines 25 et seq. the polymers claimed in instant claim 9 fall under the definition of cationic or amphoteric substantive polymers.

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Applicant is advised that should claim 9 and 10 be found allowable, claims 12-15 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 9-15, 25, 36, 39, 52 and 71 are rejected under 35 U.S.C. 102(b) as being anticipated by Ziegler et al., US 5,135,748. Example 1 in col 9 lines 1-40 is a composition comprising Quadrisoft LM-200, which is a quaternized hydroxyethylcellulose polymer comprising a fatty acid lauryl chain which contains 12 carbon atoms.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 9-15, 25, 36, 39, 52 and 71 are rejected under 35 U.S.C. 103(a) as being unpatentable over FR 2,717,383 and its US equivalent, Cotteret et al., US 5,735,908. The specification of the US patent will be used in the citations in

this rejection. Patentees teach the use of Quadrisoft LM 200, a hydroxyethylcellulose quaternary ammonium polymer having an alkyl group containing 12 carbon atoms (a lauryl group) in hair dyeing compositions which are mixed with oxidizing agents. See col 3 lines 39-48. The reference differs from the instant claims in not providing a working example of said polymer in a composition. In example 2 patentee provides a composition comprising Mirapol A15 quaternary polyammonium polymer which is mixed with the oxidizing agent hydrogen peroxide. It would have been obvious to one having skill in the art at the time the invention was made to substitute Quadrisoft LM 200 for all or part of the Mirapol A15 in example 2 because patentee teaches that the two polymers are equivalent in that they serve the same purpose in the hair compositions, that is, ~~they~~ the dyeing compositions to which they are added exhibit markedly enhanced selectivity compared with those known hitherto, are more intense and remain very resistant to atmospheric agents and to cosmetic treatments. See Col 1 lines 50 et seq. Alternatively it would have been obvious to the skilled artisan to form a composition comprising only the oxidizing agent and polymer because patentee states at column 2 lines 43 et seq. that the process of the invention may be varied by adding the oxidizing agent to the cationic or substantive polymer and forming a composition comprising the two components without the dye components, and then using that composition with the dye components. See Cotteret et al., column 2 lines 42-59.

The following two patents teach the addition of polyquaternium 24, which comprises the same polymer as Quadrisoft LM 200, to peroxide containing compositions. However the rejections over these patents are deemed cumulative to the above rejections.

Herb et al., US 5,589,177

Hagan et al., US 5,490,955

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret Einsmann whose telephone number is 571-272-1314. The examiner can normally be reached on 7:00 AM - 4:30 PM M-W and alternate Fridays. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on 571-272-1316.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

12/20/04

Margaret Einsmann
Primary Examiner
Art Unit 1751